

Response under 37 C.F.R. 1.116  
- Expedited Examining Procedure -  
Examining Group 1794

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of

Inventor(s):

Olivier J. Poncelet, et al.

INKJET RECORDING ELEMENT

Serial No.: 10/522,006

Filed: January 14, 2005

Group Art Unit: 1794

Examiner: David J. Joy

Confirmation No. 4921

Commissioner for Patents  
Alexandria, VA 22313-1450

Sir:

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Applicants request review of the final rejection in the above identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal. The review is requested based on the following arguments.

**ARGUMENTS**

Claims 1-3 and 5-19 stand rejected under 35 U.S.C. 102(e) as being anticipated by Liu et al. According to the Examiner:

Liu teaches an ink jet recording element that contains a support and at least one ink-receiving layer ... a hydrosoluble binder ... and an aluminosilicate polymer that is dispersed in the binder matrix ... has an Al/Si molar ratio between 1 and 4 ... Claims 1-16 are viewed as product-by-process claims and hence the methods that the aluminosilicate is created by are not pertinent, unless applicant can show a different product is produced ...

Applicants respectfully submit that it is clear error to hold that Liu et al. anticipates the present claimed invention. Anticipation requires that each and every claimed element necessarily be disclosed in the applied reference. Claim 1 of the instant invention is directed towards an inkjet recording element comprising an ink-receiving layer that comprises an aluminosilicate polymer obtained by treating a mixture of aluminum and silicon alkoxide with aqueous alkali in the presence of silanol groups, the aluminum concentration, Al/Si molar ratio and alkali/Al molar ratio being maintained at specified concentrations; stirring the mixture at a temperature between 15°C and 35°C long enough to form an aluminosilicate polymer; and eliminating the by-products. For a proper anticipation rejection, the material obtained by the process of

Liu et al would need to necessarily result in an aluminosilicate polymer that is identical to the polymer obtained in accordance with the specified process of the presently claimed invention. The specified relatively low temperature preparation method, however, is clearly taught as resulting in a unique composition in comparison to aluminosilicate polymers of similar Al/Si ratios which are prepared by different processes, as evidenced by the Raman spectrum (see Figures 2 and 3) of aluminosilicate polymers of Examples 2 and 3 prepared in accordance with the invention, in comparison to the Raman spectrum (Figure 1) of a comparison aluminosilicate polymer prepared in a process employing heating substantially above ambient. These examples are consistent with Applicant's explanation that those skilled in the field of aluminosilicate chemistry understand that the nature of the resulting aluminosilicate product is extremely dependent upon the method of production. Liu et al. simply clearly does not teach use of an aluminosilicate polymer that is necessarily identical to one obtained by the specified process, and thus clearly does not anticipate the present claimed invention.

The Examiner argues that there is "nothing in the product portion of the present claims that positively recites anything more than the ink-receiving layer comprises at least one hydrosoluble binder and at least one aluminosilicate polymer." This is clear error, as the "product portion" specifically requires that such aluminosilicate polymer be obtained by the specified preparation method. Thus, the specified method of preparation is part of the "product portion" of the claim. The Examiner has committed clear error in essentially disregarding such requirement. Applicants have clearly explained and demonstrated that different aluminosilicate polymer preparation processes result in identifiably different materials (as demonstrated by the different Raman spectrum). While Applicants have not provided direct analysis of the material obtained in Liu, Applicants have explained Liu et al. is similar to the comparison example of the present invention (and similarly distinguished from the aluminosilicate polymers employed in the present invention) in that the process employed in Liu et al. includes heating substantially above ambient temperatures in order to obtain the aluminosilicate composition thereof. The process employed in Liu et al is further distinguished from that employed to obtain the polymers employed in the instant invention in that Liu et al employs isopropyl alcohol as solvent and an acid

catalyst, while the present invention polymer is formed by utilizing an alkali and water as reaction solvent, in the presence of silanol groups as claimed. In view of such stark distinctions between the processes employed in the claimed invention and that of Liu et al., in combination with the fact the skilled artisan in the field of aluminosilicate chemistry understands that the nature of the product is extremely dependent upon the method of production, and the demonstrated fact that an even closer process such as in comparison Example 1 of the present application resulted in actual identifiable distinctions in the materials obtained from those employed in the claimed invention of the instant application, it is clear that there is no reasonable basis for the Examiner's assertion that use of the aluminosilicate as prepared in Liu et al anticipates the use of aluminosilicate polymers as specified in accordance with the present claimed invention.

Applicants have provided a comparison example to a material prepared by a process believed to be substantially closer to the invention than the process employed in Liu et al, and the process employed in Liu et al is more similar to the comparison example in employing heating substantially above ambient and further distinguished from the process employed in the present invention by employing acid catalyst. Accordingly, it is unjustified to require Applicant's to perform even further testing of other materials prepared by such even further distinguished processes, as consideration of the evidence of record simply does not suggest that the material of Liu et al is identical to the material obtained in accordance with the claimed product-by-process materials. In view of the clear evidence that different aluminosilicate preparation processes result in different materials, the Examiner's allegation of anticipation is clearly improper.

In the Advisory Action mailed April 30, 2009, the Examiner argues that Applicant has provided no dispositive evidence (i.e., clear showing that the product produced by the specific process of Liu is different than that which is presently claimed) to support their position., and in doing so dismisses that above explained argument that comparison examples to a material prepared by a process substantially closer to the invention than the process employed in Liu have been provided, on the basis that the present claims are drawn to an article/product obtained by a specified process, and that even though product-by-process claims are limited and defined by the

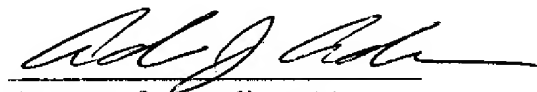
process, “determination of patentability is based on the product itself.” Such reasoning by the Examiner represents further clear error, as it fails to appreciate that Applicants have included evidence in the application as filed that the claimed product-by-process materials are identifiably different from other aluminosilicate polymers prepared by different processes, and in particular are different from other aluminosilicate polymers prepared by processes even closer than those employed in Liu, and that such product-by-process materials are accordingly not anticipated by Liu. The Examiner has entirely failed to explain why it would be reasonable to believe that the aluminosilicate polymers prepared in Liu would be identical to by the required claimed product-by-process materials, in light of the actual evidence provided in the specification that different processes result in identifiably different materials. In essence, the Examiner is arguing since direct analysis of a polymer obtained by the preparation method disclosed in Liu has not been provided, it is possible that it still “might” result in an identical polymer. The Examiner offers no reasonable technical basis for such speculative position, however, in light of the actual evidence presented by Applicants that processes even closer to that required for the claimed product-by-process materials result in identifiably different products.

The Examiner further argues that if the product in the product-by-process claim is the same “or obvious” from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process, and that although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an “unobvious difference” between the claimed product and the prior art product. Applicants have clearly explained that the required method of production for the claimed product-by-process materials results in identifiably different materials than other processes, and that “the same” material is thus not obtained. The Examiner has not, however, alleged any prima facie case of obviousness with respect to the present claimed invention, so the references by the Examiner to “or obvious” and “unobvious difference” is not understood. In any event, to the extent the materials obtained by the process required by claim 1 are identifiably different from materials prepared by other processes, and the required process itself is not suggested by the prior art, the claimed product-by-process materials were not previously known, and their use in the claimed recording element could therefore further not have been obvious. It is

respectfully submitted that Applicants have met their burden of providing evidence that the claimed product-by-process is identifiably different than products made by different processes, and that as the required process is not taught or suggested, the use of such identifiably different product in the claimed inkjet recording element would clearly not have been obvious.

In view of the above, it is clear that the proposed rejection represents clear error, and withdrawal thereof is respectfully urged.

Respectfully submitted,

  
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Attorney for Applicant(s)  
Registration No. 33,564

Andrew J. Anderson/clb  
Telephone: (585) 722-9662  
Facsimile: (585) 477-1148

If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.